

Application/ Control No.: 10/624,002
Examiner: GOLOBOY, James C

REMARKS

Applicant has amended claims 1, 11 and 14. All of the amended claims were amended to remove reference to metal salts of dibasic acids. Additionally, claims 1, 11 and 14 were amended to recite the presence of sodium sebacate in the disclosed composition. Additionally, claim 14 has been amended to include reference to antioxidants. The scope of claim 1 has been restricted by limiting the concentration of sodium sebacate to 0.5 to 5 parts by weight. Lastly, claims 8-10 have been canceled. Reference to the use of sodium sebacate and antioxidants can be found throughout the originally filed specification. See Table 2, Pending Application. Therefore, none of the amendments constitute new matter.

The Examiner has rejected claim 14 under 35 U.S.C. §112, first paragraph, as based on a non-enabling disclosure. Specifically, the Examiner cites the lack of reference to "an antioxidant" as non-enabling. Therefore, Applicant has amended claim 14 to recite antioxidants. As such, the Examiner's rejection under 35 U.S.C. 112, first paragraph, is now moot.

The Examiner has rejected claims 1, 3 and 7-14 under 35 U.S.C.103(a) as being unpatentable over Yokouchi (U.S. Patent No. 5,707,944) in view of Birke (U.S. Patent No. 3,867,399).

Claims 1 and 14, as amended, point out non-obvious subject matter because they recite that the nitrate free grease composition for avoiding abnormal peeling contains an essential component of 0.05 to 5 parts by weight of sodium sebacate. In addition, claims 1 and 14 recite a nitrate free grease composition that employs the use of polyether oil as its base oil.

The Yokouchi reference, alone or combined with other references, fails to render the amended claims obvious. The Yokouchi reference is limited to disclosing a grease composition which employs ester oil as an essential component. More importantly, Yokouchi specifically teaches, in comparative example 2, that a grease composition which comprises a polyether oil which does not contain an ester oil has poor grease properties. Therefore, there would have been no motivation to replace an ester oil with a polyether oil not containing an ester oil, because according to Yokouchi, this would produce inferior results. As such, it would not be obvious to modify the Yokouchi composition by deleting the ester oil. Furthermore, Yokouchi fails to disclose a grease composition which comprises sodium sebacate. Since Yokouchi lacks all the elements of the amended claims, it fails to render them obvious.

Application/ Control No.: 10/624,002
Examiner: GOLOBOY, James C

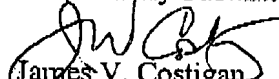
The Birke reference also fails to render amended claims 1 and 14 obvious. Birke fails to disclose or suggest adding 0.5 to 5 parts by weight of sodium sebacate to a nitrate free grease composition which comprises a thickener consisting of 100% aromatic diurea and a base oil consisting of 20% parts by weight or more of alkyl diphenyl ether oil. This combination of components allow the composition, as described in claims 1 and 14 to have excellent results in high-temperature and high-speed tests, sudden acceleration/deceleration tests, and rust preventative tests. Birke merely mentions that sodium sebacate could be used as an additive. It fails to give any guidance as to how much sodium sebacate be used or indicate the enhanced properties resulting from its use in conjunction with the other components found in the amended claims.

It is apparent from the working examples, the comparative examples, and the declared data, found in the present application that the composition described in the amended claims provide excellent results in high-temperature and high-speed tests, sudden acceleration/deceleration tests, and rust preventative test. These properties are due to the unique selection of components and their specific inclusion ratios. The cited prior art fails to point out either of these factors. Both Yokouchi and Birke fail to provide the specific range of sodium sebacate to be used. Furthermore, Youkouchi teaches away from using essential components in the composition which are found in the amended claims. As such, it is clear that the amended claims are not obvious in light of the cited prior art. Alone or combined, the prior art patents fail to point out each and every element found in the amended claims. Furthermore, no obvious modification of the prior art would render the amended claims obvious.

Applicant notes that claims 8-10 have been canceled; as such, their rejection is now moot. Claims 3, 7 and 11-13 are all dependent on claim 1. As such, they can not be obvious so long as claim 1 is non-obvious.

Favorable consideration and early allowance are respectfully requested and earnestly solicited.

Respectfully Submitted,


James V. Costigan
Registration No. 25,669

Hedman & Costigan, P.C.
1185 Avenue of the Americas
New York, N.Y. 10036-2646
(212) 302-8989